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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,480	02/27/2002	Kazuyuki Miya	L9289.02130	3434

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EXAMINER

ISMAIL, SHAWKI SAIIF

ART UNIT	PAPER NUMBER
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2455

MAIL DATE	DELIVERY MODE
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11/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYUKI MIYA,
and TOYOKI UE

Application No. 10/069,480
Technology Center 2455

Mailed: November 3, 2009

Before DELORES LOWE, *Review Team Paralegal*
LOWE, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 2, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, ARGUMENTS

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed June 8, 2009 under the heading “Argument” has not been clearly provided. Each grounds of rejection must be treated under a separate heading in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellants have not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

EXAMINER’S ANSWER, HEADINGS

A review of the file indicates that the Examiner’s Answer filed September 15, 2009 does not comply with the guidelines provided in MPEP § 1207.02 because it does not contain all of the required heading items. Specifically, the Examiner’s Answer must contain the following heading items in the following order:

- (1) *Real party in interest.*
- (2) *Related appeals and interferences.*
- (3) *Status of claims.*
- (4) *Status of amendments After Final.*
- (5) *Summary of claimed subject matter.*
- (6) *Grounds of rejection to be reviewed on appeal.*

(7) *Claims Appendix.*

(8) *Evidence Relied Upon.*

(9) *Grounds of Rejection.*

(10) *Response to Argument.*

(11) *Related Proceedings Appendix..*

An in-depth review of the Examiner's Answer indicates that the following sections are missing from the Examiner's Answer mailed September 15, 2009 and/or are not complete or clear in setting forth agreement or disagreement with the Appeal Brief:

1) "Real party in Interest",

A substitute Examiner's Answer that is in compliance with the guidelines is required. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed September 15, 2009 under the heading "Grounds of rejection to be Reviewed on Appeal" is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set

forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds that it is unclear what rejected claims are on appeal as compared to the Appeal Brief and/or the Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the brief.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims.

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on June 8, 2009 defective;
- 2) notify Appellants to file a paper properly presenting the arguments for each grounds of rejection as required;
- 3) to vacate the Examiner's Answer mailed September 15, 2009;
- 4) to generate a new Examiner's Answer in compliance with the guidelines;
- 5) to correct Grounds of rejection to be reviewed on appeal and to correct other sections of the Answer as may be required;
- 6) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and
- 7) for such further action as may be appropriate.

Application No. 10/069,480

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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